

## REMARKS

Claims 1-10 are pending in this application.

The Examiner objected to the disclosure due to several recurring informalities.

Applicants have amended the specification to correct the informalities and thanks the Examiner for pointing them out. Similarly, applicants thank the Examiner for suggesting a new title more indicative of the invention to which the claims are directed and has amended the title. Finally, applicants have amended claims 1, 4 and 6 to correct informalities pointed out by the Examiner.

The Examiner rejected claims 1-8 and 10 under 35 USC 103(a) on the combination of Ohsawa U.S. Patent No. 6,633,302 and Senn U.S. Patent No. 6,338,030. Applicants respectfully traverse this rejection. The rejection is untenable because the combination constructed by the Examiner is not the claimed invention. Thus, the invention could not have been obvious, even in hindsight. Neither Ohsawa nor Senn discloses or suggests a device that matches colors created at the transmission side with those reproduced at the receiving side of an image information transmission, as in the claimed invention.

Ohsawa is directed to a color reproduction system for obtaining an input color image signal for displaying desired colors in a color image display unit capable of displaying a color image of at least four primary colors. The Examiner admits Ohsawa fails to disclose transmitting or sending a second image data or data regarding the position of the second image data as claimed by the applicants.

The Examiner attempts to supply the missing piece by turning to Senn. However, Senn's purpose, as the Examiner admits, is to improve a measuring device of a generic type in such a way that data exchange with an external processor or with a network is possible without a manufacturer-specific data exchange protocol. This is also not the claimed invention. Ohsawa's system merely displays a color image and converts it into color image signals of primary colors. This achieves Ohsawa's desired goal of calorimetrically accurate color reproduction. On the other hand, applicants' invention has first image data formed of color components used to output

an image in a output medium, second image data measurement by a colorimeter for at least one color included in the image, and data on a position or an area of the image where a color corresponding to the second image data is present. Colors of an image outputted from an image output unit are thus enabled to coincide with those intended by a creator at an image generating unit in a system for transmitting or inputting electronic data of an image.

Even if the resulting combination suggested by the Examiner included all the claim limitations of claim 1, the cited references provide no evidence of a motivation to combine their disclosures so as to arrive at the claimed invention.

The Examiner states in the Action that it would have been obvious to modify Ohsawa with Senn to implement the image measurement data transmitting techniques of Senn with the color image correction measurements of Ohsawa in order to improve a color image measuring device, allowing external processors access to device data through data exchanges via a network without a manufacturer-specific data exchange protocol. The Examiner's alleged motivation is so general in the context of the relevant art as to constitute no more than the type of reference to a general level of skill in the art found deficient in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Under *Lee*, the Examiner must present *specific* evidence of motivation, not the kind of generalized allegation of motivation relied on in the pending Action:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

The burden imposed by *Lee* is not an impossible burden, as explained by the court in *In re Thrift*, 298 F.3d 1357, 1364-65, 63 USPQ2d 2002, 2007 (Fed. Cir. 2002), with respect to the references relied on by the Board in that case:

In the present case, the reasoning articulated by the Board is exactly the type of reasoning required by *In re Lee*. Both the examiner and the Board clearly identified a motivation to combine the references, stating that the skilled artisan

would have “found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs.” Decision on Appeal at 5; accord Aug. 7, 1996 Office Action at 3. The motivation to combine the references is present in the text of each reference. The Schmandt reference itself verifies this motivation, stating that “allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment.” Schmandt at 51. Stefanopoulos itself, while not expressly disclosing the use of speech recognition, sets forth the motivation to combine the references, stating that “there are alternative means to select the buttons, including . . . voice-activated transfer means, which may be readily adapted for use with the present invention by those skilled in the art.” ’237 patent, col. 4, ll. 34-38.

The reliance in the pending Action on the alleged ordinary skill in the art to make the suggested combination comes nowhere close to what *Lee* and *Thrift* require. It is not sufficient to say without evidentiary support, as the Examiner does in the pending Action, “It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the image measurement data transmitting techniques of Senn et al. with the color image correction measurement techniques of Ohsawa et al. in order to improve a color image measuring device, allowing external processors access to device data through data exchanges via a network without a manufacturer-specific data exchange protocol . . .” Ohsawa and Senn neither use nor suggest all the features in applicants’ claimed invention.

Finally, the Examiner has pointed to no disclosure in Senn, the alleged evidence of such a motivation, that would have motivated a person of ordinary skill in the art to use its supposed image measurement data transmitting techniques.<sup>1</sup> Applicants’ invention may be a straightforward and elegant solution to the problem it addresses, but the cited prior art is devoid of a suggestion to make it. Accordingly, the invention claimed is patentable over the prior art,

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<sup>1</sup> Applicants recognizes that an Examiner cannot search prior art to use in examining a patent application without reading the application and its claims first. That much “hindsight” is permissible and expected in the examination process. However, that is as far as hindsight in the examination process can go. Once the Examiner finds prior art that appears to be relevant based on the limited amount of hindsight that is permissible, *Lee* and *Thrift* require the Examiner to point to *evidence* within the prior art *itself* as to why persons of ordinary skill in the art would have been motivated to combine the disclosures so as to arrive at the claimed invention. Applicants’ position rests on the Examiner’s failure to produce and rely on objective evidence of motivation in the prior art itself.

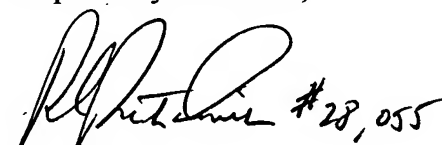
and claim 1 should be allowed. This logic also disposes of claims 2-8 and 10, which depend directly or indirectly from claim 1.

The Examiner rejected claim 9 under 35 USC 103(a) as being unpatentable over the combination of Ohsawa, Senn and Sato U.S. Patent No. 6,125,199. This rejection is also respectfully traversed for the same reasons as above, and because claim 9 depends indirectly from claim 1.

In view of the above, each of the claims in this application is in condition for allowance. Accordingly, applicants solicit early action in the form of a Notice of Allowance.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Docket No. 325772027800.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Brian N. Fletcher #28,055", is written over a horizontal line.

Brian N. Fletcher  
Registration No. 51,683

Dated: December 28, 2004

Morrison & Foerster LLP  
1650 Tysons Boulevard, Suite 300  
McLean, Virginia 22102  
Telephone: (703) 760-7796  
Facsimile: (703) 760-7777